

## **REMARKS**

### **I. Introduction**

Claims 56, 62, 70, 72, 74, and 88 are amended in this Amendment. Claims 56 to 59, 62 to 78 and 88 to 89 are pending in the above-referenced application and are submitted for the Examiner's reconsideration. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Information Disclosure Statement**

As described in our July 28, 2005 Amendment, Applicant still has not received a copy of the initialed PTO Form 1449 which we submitted to the PTO in connection with an Information Disclosure Statement on April 2, 2001. The Examiner is respectfully requested to forward a copy of this form with the next communication to indicate receipt and review of this form.

### **III. Claim features not considered by Examiner**

It is respectfully submitted that the October 4, 2005 Office Action is incomplete. Under 37 C.F.R. § 1.104(c)(2), "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. . . . The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." (emphasis added). For example, Examiner did not address in the April 28, 2005 Office Action the feature of "the approved entity being provided the investment capital using at least some of the investor capital from the at least one investor" recited in independent claims 62, 70, 74, and 88, and continued to disregard it in the October 4, 2005 Office Action, even after the feature was added to claim 56 on page 2 in our July 28, 2005 Amendment. Further, Examiner did not address the other claim amendments in the October 4, 2005 Office Action.

Applicant respectfully requests that the Examiner consider all of the claimed features, as amended in this Amendment. As detailed in the M.P.E.P., "The listing will serve to replace all prior versions of the claims in the application." Section 714 II.C. *Amendments to the Claims*. (emphasis added). In any case, as further detailed in the remarks below, it is

respectfully submitted that the references cited by the Examiner do not render any of the pending claims obvious.

**IV. Rejection of Claims 56 to 57, 62 to 64, 65 to 71, 73 to 77, and 88 Under 35 U.S.C. § 103(a)**

Claims 56 to 57, 62 to 64, 65 to 71, 73 to 77, and 88 were rejected under 35 U.S.C. § 103(a) as obvious over McClelland (U.S. Patent No. 5,689,650) in view of Buente (“Significant Environmental Law Developments”). The Examiner stated, in support of the rejection, that McClelland discloses the invention substantially as claimed, except for failing to “particularly call for using the funds for acquiring Browfields projects, and without taking ownership (or non-recourse or passive investing) in the project,” but that Buente teaches this feature.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

The Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

It is respectfully submitted that neither reference, either alone or in combination with the other, renders the claims obvious, and thus, this rejection should be withdrawn, for at least the following reasons.

**a. Rejection of Claims 56 to 57**

Claim 56, as amended, recites the following:

A method for managing a Brownfields fund, comprising:  
storing in a computer system information relating to a Brownfields fund;  
accepting investor capital from at least one investor into the Brownfields fund;  
storing information in the computer system relating to the at least one investor, the stored information including investor identification information, investment amounts, and terms of investments;  
storing information in the computer system concerning an entity and a project involving a Brownfields, the entity having an ownership interest in the Brownfields;  
approving the entity and the Brownfields project for financing with investment capital from the Brownfields fund according to select criteria using the information stored in the computer system concerning the entity and the Brownfields project; and  
providing the investment capital from the Brownfields fund to the approved entity to at least partially finance the approved Brownfields project without taking any ownership interest in the approved Brownfields project, the approved entity being provided the investment capital using at least some of the investor capital from the at least one investor.

Claim 56 relates to a method for managing a Brownfields fund that includes using a computer system to accept investor capital into the Brownfields fund, approve an entity that has an ownership interest in the Brownfields and a Brownfields project for financing with investment capital from the Brownfields fund according to select criteria, and provide investment capital from the Brownfields fund to the approved entity to at least partially finance the approved project using at least some of the investor capital from at least one investor. Investment capital, including capital received from investors, is provided through the Brownfields fund to at least partially finance an approved Brownfields project. However, the Brownfields fund does not take any ownership interest in the approved Brownfields project.

McClelland is unrelated to the present invention. McClelland describes a computer network to distribute, i.e., sell and buy, Community Reinvestment Act mortgages to and from portfolio investors. (Col. 4, lines 43 to 47.). The CRA network allows investors the right to collect interest or payments on existing mortgages. The investor who purchases a mortgage in the CRA network from the originating bank or another investor is not financing

the purchase of a home nor determining whether money should be lent to the homeowner in the first place. The bank already financed the purchase of the home by lending the money to the homeowner. (Col. 8, lines 35 to 36; Col. 17, lines 9 to 12, 15 to 17, 25 to 28, 37 to 39.). Not only does McClelland fail to call for using the funds for Brownfields projects and without taking ownership (or non-recourse or passive investing) in the projects, as pointed out by the Examiner, McClelland fails to illustrate or describe the other features recited in claim 56, including approving the entity and the Brownfields project for financing with investment capital from the Brownfields fund, providing the investment capital from the Brownfields fund to the approved entity to at least partially finance the approved Brownfields project, and using at least of the investor capital from the at least one investor to provide the investment capital.

It is respectfully submitted that Buente fails to cure these defects. The article entitled "Significant Environmental Law Developments" describes existing laws and decisions concerning the liability of lenders to Brownfield redevelopment projects. There is no mention or suggestion in Buente concerning any funding provided to the lender in Buente so that the lender can make the loan in the first place, or the approval of a project by the lender, or any other structure of a Brownfields fund remotely resembling that described in the present invention.

Thus, Buente clearly neither illustrates nor describes managing a Brownfields fund with the use of information from a computer system, including the steps of accepting investor capital from at least one investor into the fund, approving the Brownfields owning entity and the Brownfields project for financing with investment capital from the Brownfields fund according to select criteria, and providing the investment capital from the Brownfields fund to the approved entity to at least partially finance the approved Brownfields project using at least some of the investor capital from the at least one investor without taking an ownership interest in the Brownfields project, as recited in claim 56.

Further, it is respectfully submitted that McClelland and Buente are unrelated to each other, and that there is no teaching, suggestion or motivation to modify or combine McClelland and Buente as suggested by the Examiner.

Therefore, it is respectfully submitted that the combination of McClelland and Buente does not render obvious claim 56, and this rejection should be withdrawn.

As for claim 57, which ultimately depends from claim 56 and therefore include all of the features recited in claim 56, it is respectfully submitted that the rejection of this claim should be withdrawn, as well.

**b. Rejection of Claims 62 to 64, and 65 to 69**

Claim 62, as amended, recites the following:

A method for investing in Brownfields using a computer system, comprising:

- establishing a Brownfields fund, the Brownfields fund providing investment capital for Brownfields projects and the Brownfields fund remaining passive with respect to the Brownfields projects;

- receiving an indication of investor capital from investors into the Brownfields fund by the computer system;

- approving an entity for the investment capital from the Brownfields fund to at least partially finance a respective one of the Brownfields projects, the entity having an ownership interest in a Brownfields associated with the one of the Brownfields projects; and

- providing an indication of the investment capital by the computer system from the Brownfields fund to the approved entity, the approved entity being provided the investment capital using at least some of the investor capital from the investors.

Claim 62 relates to a method for investing in Brownfields that includes using a computer system to establish a Brownfields fund that provides investment capital for Brownfields projects while the Brownfields fund remains passive with respect to the projects, receive an indication of investor capital from investors into the Brownfields fund, approve an entity that has an ownership interest in the Brownfields for investment capital from the Brownfields fund to at least partially finance a Brownfields project according to select criteria, and provide an indication of the investment capital provided from the Brownfields fund to the approved entity for the approved project using at least some of the investor capital from the investors. Investment capital, including capital received from investors, is provided through the Brownfields fund to at least partially finance an approved Brownfields project. However, the Brownfields fund remains passive with respect to the approved Brownfields project.

As described above, McClelland is unrelated to the present invention.

McClelland describes a computer network to distribute, i.e., sell and buy, Community Reinvestment Act mortgages to and from portfolio investors. (Col. 4, lines 43 to 47.). The CRA network allows investors the right to collect interest or payments on existing mortgages. The investor who purchases a mortgage in the CRA network from the originating bank or another investor is not financing the purchase of a home nor determining whether money

should be lent to the homeowner in the first place. The bank already financed the purchase of the home by lending the money to the homeowner. (Col. 8, lines 35 to 36; Col. 17, lines 9 to 12, 15 to 17, 25 to 28, 37 to 39.). Not only does McClelland fail to call for using the funds for Brownfields projects and without taking ownership (or non-recourse or passive investing) in the projects, as pointed out by the Examiner, McClelland fails to illustrate or describe the other features recited in claim 62, including approving the entity for the investment capital from the Brownfields fund to at least partially finance a Brownfields project, providing an indication of the investment capital from the Brownfields fund to the approved entity, the approved entity being provided the investment capital using at least some of the investor capital from the investors.

It is respectfully submitted that Buente fails to cure these defects. There is no mention or suggestion in Buente concerning any funding provided to the lender in Buente so that the lender can make the loan in the first place, or the approval of a project by the lender, or any other structure of a Brownfields fund remotely resembling that described in the present invention. Thus, Buente clearly neither illustrates nor describes investing in Brownfields with the use of information from a computer system, including the steps of establishing a Brownfields fund that provides investment capital while the Brownfields fund remains passive with respect to Brownfields projects, receiving an indication of investor capital from investors, approving an entity who has an ownership interest in the Brownfields for the investment capital from the fund to at least partially finance a Brownfields project, and providing an indication of the investment capital from the fund to the approved entity, the approved entity being provided the investment capital using at least some of the investor capital, as recited in claim 62.

Further, it is respectfully submitted that McClelland and Buente are unrelated to each other, and that there is no teaching, suggestion or motivation to modify or combine McClelland and Buente as suggested by the Examiner.

Therefore, it is respectfully submitted that the combination of McClelland and Buente does not render obvious claim 62, and this rejection should be withdrawn.

As for claims 63 to 64, and 65 to 69, which ultimately depend from claim 62 and therefore include all of the features recited in claim 62, it is respectfully submitted that the rejection of these claims should be withdrawn, as well.

c. **Rejection of Claims 70 to 71 and 73**

Claim 70, as amended, recites the following:

A method for investing in Brownfields using a computer system, comprising:  
establishing a Brownfields fund, the Brownfields fund providing investment capital on a non-recourse basis for Brownfields projects and the Brownfields fund remaining passive with respect to the Brownfields projects;  
receiving an indication of investor capital from investors into the Brownfields fund by the computer system;  
approving an entity for the investment capital from the Brownfields fund on the non-recourse basis to at least partially finance a respective one of the Brownfields projects, the entity having an ownership interest in a Brownfields associated with the one of the Brownfields projects; and  
providing an indication of the investment capital on the non-recourse basis from the Brownfields fund to the approved entity by the computer system, the approved entity being provided the investment capital using at least some of the investor capital from the investors.

Claim 70 relates to a method for investing in Brownfields that includes using a computer system to establish a Brownfields fund that provides investment capital to Brownfields projects on a non-recourse basis and the Brownfields fund remaining passive with respect to the Brownfields projects, receive an indication of investor capital from investors into the Brownfields fund, approve an entity that has an ownership interest in the Brownfields for investment capital from the Brownfields fund on the non-recourse basis to at least partially finance a Brownfields project according to select criteria, and provide an indication of the investment capital from the Brownfields fund to the approved entity, the approved entity being provided the investment capital using at least some of the investor capital from the investors. Investment capital, including capital received from investors, is provided through the Brownfields fund on a non-recourse basis to at least partially finance an approved Brownfields project. However, the Brownfields fund remains passive with respect to the approved Brownfields project.

As described above, McClelland is unrelated to the present invention. McClelland describes a computer network to distribute, i.e., sell and buy, Community Reinvestment Act mortgages to and from portfolio investors. (Col. 4, lines 43 to 47.). The CRA network allows investors the right to collect interest or payments on existing mortgages. The investor who purchases a mortgage in the CRA network from the originating bank or another investor is not financing the purchase of a home nor determining whether money

should be lent to the homeowner in the first place. The bank already financed the purchase of the home by lending the money to the homeowner. (Col. 8, lines 35 to 36; Col. 17, lines 9 to 12, 15 to 17, 25 to 28, 37 to 39.). Not only does McClelland fail to call for using the funds for Brownfields projects and without taking ownership (or non-recourse or passive investing) in the projects, as pointed out by the Examiner, McClelland fails to illustrate or describe the other features recited in claim 70, including approving the entity for the investment capital from the Brownfields fund to at least partially finance a Brownfields project, providing an indication of the investment capital from the Brownfields fund to the approved entity, the approved entity being provided the investment capital using at least some of the investor capital from the investors.

It is respectfully submitted that Buente fails to cure these defects. There is no mention or suggestion in Buente concerning any funding provided to the lender in Buente so that the lender can make the loan in the first place, or the approval of a project by the lender, or any other structure of a Brownfields fund remotely resembling that described in the present invention. Thus, Buente clearly neither illustrates nor describes a method for investing in Brownfields with the use of information from a computer system, including the steps of establishing a Brownfields fund that provides investment capital on a non-recourse basis while the Brownfields fund remains passive with respect to Brownfields projects, receiving an indication of investor capital from investors, approving an entity who has an ownership interest in the Brownfields for the investment capital on the non-recourse basis to at least partially finance a Brownfields project, and providing an indication of the investment capital on the non-recourse basis from the fund to the approved entity, the approved entity being provided the investment capital using at least some of the investor capital, as recited in claim 70.

Further, it is respectfully submitted that McClelland and Buente are unrelated to each other, and that there is no teaching, suggestion or motivation to modify or combine McClelland and Buente as suggested by the Examiner.

Therefore, it is respectfully submitted that the combination of McClelland and Buente does not render obvious claim 70, and this rejection should be withdrawn.

As for claims 71 and 73, which ultimately depend from claim 70 and therefore include all of the features recited in claim 70, it is respectfully submitted that the rejection of these claims should be withdrawn, as well.



d. **Rejection of Claims 74 to 77**

Claim 74, as amended, recites the following:

A method for investing in Brownfields using a computer system, comprising:  
establishing a Brownfields fund, the Brownfields fund providing investment capital for Brownfields projects and the Brownfields fund remaining passive with respect to the Brownfields projects;  
receiving an indication of investor capital from investors into the Brownfields fund by the computer system;  
approving an entity for the investment capital from the Brownfields fund to at least partially finance a respective one of the Brownfields projects according to predetermined criteria, the entity having an ownership interest in a Brownfields associated with the one of the Brownfields projects; and  
providing an indication of the investment capital to the approved entity from the Brownfields fund by the computer system, the approved entity being provided the investment capital using at least some of the investor capital from the investors.

Claim 74 relates to a method for investing in Brownfields that includes using a computer system to establish a Brownfields fund that provides investment capital while the Brownfields fund remains passive with respect to Brownfields projects, receive an indication of investor capital from investors into the Brownfields fund, approve an entity who has an ownership interest in the Brownfields for investment capital from the Brownfields fund to at least partially finance a Brownfields project according to predetermined criteria, and provide an indication of the investment capital to the approved entity from the Brownfields fund by the computer system, the approved entity being provided investment capital using at least some of the investor capital from the investors. Investment capital, including capital received from investors, is provided through the Brownfields fund to at least partially finance an approved Brownfields project. However, the Brownfields fund remains passive with respect to the approved Brownfields project.

As described above, McClelland is unrelated to the present invention. McClelland describes a computer network to distribute, i.e., sell and buy, Community Reinvestment Act mortgages to and from portfolio investors. (Col. 4, lines 43 to 47.). The CRA network allows investors the right to collect interest or payments on existing mortgages. The investor who purchases a mortgage in the CRA network from the originating bank or another investor is not financing the purchase of a home nor determining whether money

should be lent to the homeowner in the first place. The bank already financed the purchase of the home by lending the money to the homeowner. (Col. 8, lines 35 to 36; Col. 17, lines 9 to 12, 15 to 17, 25 to 28, 37 to 39.). Not only does McClelland fail to call for using the funds for Brownfields projects and without taking ownership (or non-recourse or passive investing) in the projects, as pointed out by the Examiner, McClelland fails to illustrate or describe the other features recited in claim 74, including approving the entity for the investment capital from the Brownfields fund to at least partially finance a Brownfields project, providing an indication of the investment capital to the approved entity from the Brownfields fund by the computer system, the approved entity being provided the investment capital using at least some of the investor capital from the investors.

It is respectfully submitted that Buente fails to cure these defects. There is no mention or suggestion in Buente concerning any funding provided to the lender in Buente so that the lender can make the loan in the first place, or the approval of a project by the lender, or any other structure of a Brownfields fund remotely resembling that described in the present invention. Thus, Buente clearly neither illustrates nor describes a method for investing in Brownfields with the use of a computer system, including the steps of establishing a Brownfields fund that provides investment capital for Brownfields projects while the Brownfields fund remains passive with respect to the Brownfields projects, receiving an indication of investor capital from investors into the Brownfields fund by the computer system, approving an entity who has an ownership interest in the Brownfields for the investment capital from the Brownfields fund to at least partially finance a Brownfields project according to predetermined criteria, and providing an indication of the investment capital from the fund to the approved entity by the computer system, the approved entity being provided the investment capital using at least some of the investor capital from the investors, as recited in claim 74.

Further, it is respectfully submitted that McClelland and Buente are unrelated to each other, and that there is no teaching, suggestion or motivation to modify or combine McClelland and Buente as suggested by the Examiner.

Therefore, it is respectfully submitted that the combination of McClelland and Buente does not render obvious claim 74, and this rejection should be withdrawn.

As for claims 75 to 77, which ultimately depend from claim 74 and therefore include all of the features recited in claim 74, it is respectfully submitted that the rejection of these claims should be withdrawn, as well.

e. **Rejection of Claims 88**

Claim 88, as amended, recites the following:

A method of investing in Brownfields using a computer system, comprising:

providing, by the computer system, an indication of investor capital into a Brownfields fund by an investor to the Brownfields fund in accordance with predetermined terms of investment, the Brownfields fund providing investment capital for Brownfields projects and the Brownfields fund remaining passive with respect to the Brownfields projects, the Brownfields fund approving an entity for the investment capital from the Brownfields fund to at least partially finance a respective one of the Brownfields projects according to select criteria, the entity having an ownership interest in a Brownfields associated with the one of the Brownfields projects, an indication of the investment capital being provided to the approved entity from the Brownfields fund by the computer system, the approved entity being provided the investment capital using at least some of the investor capital from the investor without the Brownfields fund taking any ownership interest in a Brownfields property associated with the one of the Brownfields projects; and receiving by the investor from the computer system an indication of a return on investment, the return on investment being determined as a function of the predetermined terms of investment.

Claim 88 relates to a method for investing in Brownfields fund that includes using a computer system to provide an indication of investor capital into a Brownfields fund, and receive an indication of a return on investment. The Brownfields fund provides investment capital for Brownfields projects and the Brownfields fund remains passive with respect to the Brownfields projects. The Brownfields fund approves an entity who has an ownership interest in a Brownfields to receive the investment capital from the Brownfields fund to at least partially finance a Brownfields project according to select criteria. The Brownfields fund provides the investment capital to the approved entity using at least some of the investor capital without taking any ownership interest in the Brownfields property associated with the project. The return on the investment is determined as a function of the predetermined terms of investment.

As described above, McClelland is unrelated to the present invention. McClelland describes a computer network to distribute, i.e., sell and buy, Community Reinvestment Act mortgages to and from portfolio investors. (Col. 4, lines 43 to 47.). The CRA network allows investors the right to collect interest or payments on existing mortgages.

The investor who purchases a mortgage in the CRA network from the originating bank or another investor is not financing the purchase of a home nor determining whether money should be lent to the homeowner in the first place. The bank already financed the purchase of the home by lending the money to the homeowner. (Col. 8, lines 35 to 36; Col. 17, lines 9 to 12, 15 to 17, 25 to 28, 37 to 39.). Not only does McClelland fail to call for using the funds for Brownfields projects and without taking ownership (or non-recourse or passive investing) in the projects, as pointed out by the Examiner, McClelland fails to illustrate or describe the other features recited in claim 88, including providing an indication of investor capital by an investor into the Brownfields fund, the Brownfield fund approving an entity who has an ownership interest in a Brownfields for investment capital from the Brownfields fund to at least partially finance a Brownfields project, the Brownfields fund providing the investment capital to the entity using at least some of the investor capital, and receiving an indication of a return on investment.

It is respectfully submitted that Buente fails to cure these defects. There is no mention or suggestion in Buente concerning any funding provided to the lender in Buente so that the lender can make the loan in the first place, or the approval of a project by the lender, or any other structure of a Brownfields fund remotely resembling that described in the present invention. Thus, Buente clearly neither illustrates nor describes a method of investing in Brownfields with the use of a computer system, including the steps of: providing an indication of investor capital by an investor into a Brownfields fund, the Brownfields fund approving an entity with an ownership interest in a Brownfields for investment capital from the Brownfields fund to at least partially finance a Brownfields project, the Brownfields fund remaining passive with respect to the Brownfields projects, the Brownfields fund providing investment capital from the Brownfields fund using at least some of the investor capital in the fund without the Brownfields fund taking any ownership interest in a Brownfields property associated with the Brownfields project; and receiving an indication of a return on investment based on the predetermined terms of investment, as recited in claim 88.

Further, it is respectfully submitted that McClelland and Buente are unrelated to each other, and that there is no teaching, suggestion or motivation to modify or combine McClelland and Buente as suggested by the Examiner.

Therefore, it is respectfully submitted that the combination of McClelland and Buente does not render obvious claim 88, and this rejection should be withdrawn.

**V. Rejection of Claims 58 to 59, 78 and 89 Under 35 U.S.C. § 103(a)**

Claims 58 to 59, 78 and 89 were rejected under 35 U.S.C. §103(a) as obvious over McClelland and Buente in view of Slutzky (“EPA’s Brownfields Initiatives”). The Examiner stated, in support of the rejection, that McClelland and Buente disclose the invention substantially as claimed, except for failing to “particularly call for exchanging an interest in future cash flows from the project for the investment capital,” but that Slutzky teaches this feature. It is respectfully submitted that the combination of McClelland, Buente and Slutzky does not render obvious the present independent claims for at least the following reasons.

**a. Rejection of Claims 58 to 59**

Claims 58 to 59 ultimately depend from and include all of the features recited in claim 56. As described above, claim 56 relates to a method for managing a Brownfields fund that includes using a computer system to accept investor capital into the Brownfields fund, approve an entity that has an ownership interest in the Brownfields and a Brownfields project for financing with investment capital from the Brownfields fund according to select criteria, and provide investment capital from the Brownfields fund to the approved entity to at least partially finance the approved project using at least some of the investor capital from at least one investor. Investment capital, including capital received from investors, is provided through the Brownfields fund to at least partially finance an approved Brownfields project. However, the Brownfields fund does not take any ownership interest in the approved Brownfields project.

Also as described above, neither McClelland nor Buente illustrate or describe managing a Brownfields fund with the use of information from a computer system, including the steps of accepting investor capital from at least one investor into the fund, approving the Brownfields owning entity and the Brownfields project for financing with investment capital from the Brownfields fund according to select criteria, and providing the investment capital from the Brownfields fund to the approved entity to at least partially finance the approved Brownfields project without taking an ownership interest in the Brownfields project using at least some of the investor capital from the at least one investor, as recited in claim 56.

It is respectfully submitted that Slutzky fails to cure these defects. The article entitled “EPA’s Brownfields Initiatives” describes recent action by the EPA and possible reactions by lenders to Brownfield sites. There is no mention or suggestion in Slutzky concerning any funding provided to the lender in Slutzky so that the lender can make the loan in the first place, or the approval of a project by the lender, or any other structure of a

Brownfields fund remotely resembling that described in the present invention. Thus, Slutzky clearly neither illustrates nor describes managing a Brownfields fund with the use of information from a computer system, including the steps of accepting investor capital from at least one investor into the fund, approving the Brownfields owning entity and the Brownfields project for financing with investment capital from the Brownfields fund according to select criteria, and providing investment capital from the Brownfields fund to the approved entity to at least partially finance the approved Brownfields project without taking an ownership interest in the project, using at least some of the investor capital from the at least one investor, as recited in claim 56.

Further, it is respectfully submitted that Buente and Slutzky are unrelated to McClelland, and that there is no teaching, suggestion or motivation to modify or combine McClelland, Buente and Slutzky as suggested by the Examiner.

Therefore, it is respectfully submitted that the combination of McClelland, Buente and Slutzky does not render obvious claim 56. Since claims 58 to 59 ultimately depend from claim 56 and therefore include all of the features recited in claim 56, it is respectfully submitted that the rejection of claims 58 to 59 should be withdrawn.

**b. Rejection of Claim 78**

Claim 78 ultimately depends from and include all of the features recited in claim 74. As described above, claim 74 relates to a method for investing in Brownfields that includes using a computer system to establish a Brownfields fund that provides investment capital while the Brownfields fund remains passive with respect to Brownfields projects, receive an indication of investor capital from investors into the Brownfields fund, approve an entity who has an ownership interest in the Brownfields for investment capital from the Brownfields fund to at least partially finance a Brownfields project according to predetermined criteria, and provide an indication of the investment capital to the approved entity from the Brownfields fund by the computer system, the approved entity being provided investment capital using at least some of the investor capital from the investors. Investment capital, including capital received from investors, is provided through the Brownfields fund to at least partially finance an approved Brownfields project. However, the Brownfields fund remains passive with respect to the approved Brownfields project.

Also as described above, neither McClelland nor Buente clearly illustrate or describe a method for investing in Brownfields with the use of information from a computer system, including the steps of establishing a Brownfields fund that provides investment

capital while the Brownfields fund remains passive with respect to Brownfields projects, receiving an indication of investor capital from investors, approving an entity who has an ownership interest in the Brownfields for the investment capital from the Brownfields fund to at least partially finance a Brownfields project according to predetermined criteria, and providing an indication of the investment capital from the fund to the approved entity, the approved entity being provided the investment capital using at least some of the investor capital from the investors, as recited in claim 74.

It is respectfully submitted that Slutzky fails to cure these defects. There is no mention or suggestion in Slutzky concerning any funding provided to the lender in Slutzky so that the lender can make the loan in the first place, or the approval of a project by the lender, or any other structure of a Brownfields fund remotely resembling that described in the present invention. Thus, Slutzky clearly neither illustrates nor describes a method for investing in Brownfields with the use of information from a computer system, including the steps of establishing a Brownfields fund that provides investment capital while the Brownfields fund remains passive with respect to Brownfields projects, receiving an indication of investor capital from investors, approving an entity who has an ownership interest in the Brownfields for the investment capital from the Brownfields fund to at least partially finance a Brownfields project according to predetermined criteria, and providing an indication of the investment capital from the fund, the approved entity being provided the investment capital using at least some of the investor capital from the investors, as recited in claim 74.

Further, it is respectfully submitted that Buente and Slutzky are unrelated to McClelland, and that there is no teaching, suggestion or motivation to modify or combine McClelland, Buente and Slutzky as suggested by the Examiner.

Therefore, it is respectfully submitted that the combination of McClelland, Buente and Slutzky does not render obvious claim 74. Since claim 78 ultimately depends from claim 74 and therefore include all of the features recited in claim 74, it is respectfully submitted that the rejection of claim 78 should be withdrawn.

**d. Rejection of Claim 89**

Claim 89 ultimately depends from and include all of the features recited in claim 88. As described above, claim 88 relates to a method for investing in Brownfields fund that includes using a computer system to provide an indication of investor capital into a Brownfields fund, and receive an indication of a return on investment. The Brownfields fund provides investment capital for Brownfields projects and the Brownfields fund remains

passive with respect to the Brownfields projects. The Brownfields fund approves an entity who has an ownership interest in a Brownfields to receive the investment capital from the Brownfields fund to at least partially finance a Brownfields project according to select criteria. The Brownfields fund provides the investment capital to the approved entity using at least some of the investor capital without taking any ownership interest in the Brownfields property associated with the project. The return on the investment is determined as a function of the predetermined terms of investment.

Also as described above, neither McClelland nor Buente clearly illustrate or describe a method of investing in Brownfields with the use of information from a computer system, including the steps of providing an indication of investor capital into the Brownfields fund, the Brownfields fund providing investment capital for Brownfields projects and the Brownfields fund remaining passive with respect to the Brownfields projects, the Brownfields fund approving an entity with an ownership interest in a Brownfields for the investment capital from the Brownfields fund to at least partially finance a Brownfields project according to select criteria; the investment capital from the Brownfields fund being provided using at least some of the investor capital in the fund without the Brownfields fund taking any ownership interest in a Brownfields property associated with the Brownfields project; and receiving an indication of a return on investment based on the predetermined terms of investment, as recited in claim 88.

It is respectfully submitted that Slutzky fails to cure these defects. There is no mention or suggestion in Slutzky concerning any funding provided to the lender in Slutzky so that the lender can make the loan in the first place, or the approval of a project by the lender, or any other structure of a Brownfields fund remotely resembling that described in the present invention. Thus, Slutzky clearly neither illustrates nor describes a method of investing in Brownfields with the use of information from a computer system, including the steps of providing an indication of investor capital into the Brownfields fund, the Brownfields fund providing investment capital for Brownfields projects and the Brownfields fund remaining passive with respect to the Brownfields projects, the Brownfields fund approving an entity with an ownership interest in a Brownfields for the investment capital from the Brownfields fund to at least partially finance a Brownfields project according to select criteria; the investment capital from the Brownfields fund being provided using at least some of the investor capital in the fund without the Brownfields fund taking any ownership interest in a Brownfields property associated with the Brownfields project; and receiving an indication of



a return on investment based on the predetermined terms of investment, as recited in claim 88.

Further, it is respectfully submitted that Buente and Slutzky are unrelated to McClelland, and that there is no teaching, suggestion or motivation to modify or combine McClelland, Buente and Slutzky as suggested by the Examiner.

Therefore, it is respectfully submitted that the combination of McClelland, Buente and Slutzky does not render obvious claim 88. Since claim 89 ultimately depends from claim 88 and therefore include all of the features recited in claim 88, it is respectfully submitted that the rejection of claim 89 should be withdrawn.

## **VI. Obviousness**

As further regards all of the above obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and there must be a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). It is respectfully submitted that the references relied upon simply do not address the problems (referred to in the present application) that are met by the address filter subject matter of any of the rejected claims.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action's assertions that it would have been obvious to modify or combine the references relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. The primary reference cited by the Examiner, McClelland, is unrelated to the secondary references Buente and Slutzky.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in

rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). As referred to above, any review of the references relied upon makes plain that they simply do not describe the features discussed above of the rejected claims.

## **VII. Claim 72**

Applicant respectfully requests the status of claim 72. Claim 72 is listed as one of the rejected claims in the Summary, however the Examiner does not provide any basis for the rejection in the October 4, 2005 Office Action. Claim 72 was rewritten in independent form in our July 28, 2005 Amendment in response to the Examiner's objection of the dependent claim in the April 28, 2005 Office Action as containing allowable subject matter. It is therefore respectfully submitted that claim 72 is in condition for immediate allowance, and any rejection of claim 72 should be withdrawn.

## **VIII. Response to Arguments**

Applicant notes with appreciation Examiner's consideration of Applicant's remarks. Claims 62, 70, 72, 74 and 88 which recite "remaining passive" have been amended to clarify that it is the Brownfields fund that remains passive with respect to the Brownfields projects.

Applicant respectfully disagrees with the Examiner's characterization of McClelland. Column 7, lines 39 to 42 in McClelland concern when the network may receive an investor's funds before the network has identified and bought qualified mortgages. The CRA assets are CRA eligible loans (and the originating banks have already lent the money to the homeowner). (Col. 4, lines 10-14.). The investor who purchases a mortgage in the CRA network from the originating bank or another investor is not financing the purchase of a home nor determining whether money should be lent to the homeowner in the first place. The claimed limitations that McClelland fails to disclose are detailed above in this Amendment in Sections IV and V, including, for example, failing to suggest or describe the following steps recited in claim 56: approving an entity that has an ownership interest in the Brownfields and the Brownfields project for financing with investment capital from the Brownfields fund, and providing the investment capital from the Brownfields fund to the approved entity to at least partially finance the approved Brownfields project using at least some of the investor capital from the at least one investor.

It is respectfully submitted that the failure of McClelland to suggest or describe entire steps recited in the claimed methods does not require Applicant to specify an order to the steps in addition to the order already specified in the claims. For example, in claim 56, the investment capital is provided to the approved entity, indicating that the step of approving the entity precedes the step of providing the investment capital.

Additionally, although Buente references "nonsecured lenders," it is respectfully submitted that Buente does not address the funding provided to the lender so that the lender can make the loan in the first place, or the approval of a project by the lender, or any other structure of a Brownfields fund remotely resembling that described in the present invention.

Finally, as mentioned above, it is respectfully submitted that Buente and Slutzky are unrelated to McCelland. Thus, absent any suggestion or motivation to combine the features in McClelland, Buente or Slutzky in the manner described by the Examiner, none of these references, whether alone or in combination with each other, render the claimed methods obvious.

#### **IX. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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